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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,125	04/30/2001	David Landis Fisher JR.		1919

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EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,125

Applicant(s)

FISHER, DAVID LANDIS

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 November 2005 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 5/20/2005, applicant cancels claims 2-4, and 14-16, and amends claims 1, 5, 6, and 10. The following claims 1 and 5-13 are presented for examination.

1.1 In response to communications filed on 11/28/2005, Applicant has amended the specification and the drawings to overcome the objection from the last Office Action. However, the abstract should be limited to one paragraph and does not overcome the objection. The amendment to the drawing has been considered and the objection to the drawing has been withdrawn.

1.2 Applicant's remarks, filed on 10/22/2004, with respect to the rejection of claims have been fully considered but they are moot in view of the new ground(s) of rejection.

Specification

2. The abstract of the disclosure is objected to because it contains more than one paragraph. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the

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printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2.1 The amendment to the specification proposed by Applicant to the specification page 7, line 22 to replace "311-31x" with "310" is not proper and should not be entered because 310 is described as a new application on line 34 and 310-31x are applications to be loaded in directory 300 (see figure 1).

Claim Objections

3. **Claim 1** is objected to because of the following informalities: the period (.) on line 13 should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 6 and 11 and the intervening claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 Claims 6 and 11 recite “further consisting” and are dependent of claims 1 and 10 respectively already “consisting” of a number of limitations. Appropriate correction is requested. Applicant is suggested to use an open ended limitation in this case such as “comprising”.

4.2 Claim 10 recites the limitation "derive a new master unlock key and write this back to the remaining card... so that this method can be repeated" on line 2. There is insufficient antecedent basis for this limitation in the claim. It is not definite as to what is written and what method is repeated. Appropriate correction is requested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.1 Claims 1 and 10 and the intervening claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant’s disclosure fails to recite “binary files”. In

addition, the last paragraph in claim 1, lines 27-30 reciting “the specific binary file from where the application provider first retrieved the master card unlock key file is then rendered unusable thereby restricting these as one time only keys” cannot be found by Examiner in the disclosure. Applicant is requested to clearly specify where in the specification the above limitations are described or delete the new matter in the claims.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 and the intervening claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 recites a method embodied as a software program. It is not clear whether the claimed invention is claiming a method or a program, it appears that the claim is erroneously directed to both a method and a program and in addition the program is not embodied into a tangible medium such as a computer readable medium to make the program executable. Applicant is suggested to clearly limit the claim to either a method or a program and uses proper language as required in the MPEP to avoid non-statutory subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7.1 **Claims 10-13** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,929,428 to **Iijima**.

As per claim 10, Iijima discloses a method and apparatus for the Card Issuer to selectively empower third parties to be able to load applications to the smart card, consisting of the following steps: assign to the third party a previously unallocated binary file that has been preloaded on the card, for example (see column 12, lines 16-25); invoke the permission allocated to the third party for read access to their assigned binary file most likely in the form of presenting a key to the card, for example (see column 12, lines 16-43 and column 10, lines 13-15); execute the master "card unlock key" value as read from the binary file in order to unlock the card (see column 12, lines 35-45); enable the creation of files and loading of application data to the card (column 12, lines 35-50 and column 13, lines 5-10 and column 4, lines 29-33); derive a new

master “card unlock key” and write this back to the remaining card binary files so that this method can be repeated (column 4, lines 29-53).

As per claim 11, Iijima discloses the limitation of further consisting of a secure process for individually authorizing and controlling application loading, for example (see column 14, lines 10-25).

As per claim 12, Iijima discloses the limitation of wherein the authorization can be granted after the card has been placed in circulation, for example (see column 4, lines 29-53 and column 14, lines 10-25).

As per claim 13, Iijima discloses the limitation of wherein the Card Issuer maintains a reversionary ownership interest in the card such that applications can be inactivated or removed, for example (see column 5, lines 25-65 and column 12, lines 16-42).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8.1 **Claims 1, 5-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,929,428 to **Iijima**.

8.2 **As per claims 1 and 5, Iijima** substantially discloses a method for the secure and controlled loading of applications onto a conventional file system smart card without the benefit of card based cryptographic services or card operating system customizations consisting of the following steps: preloading of a plurality files that will each store the current master “card unlock key”, where each binary file can be freely updated but read only with the proper access authorization, for example (see column 5, lines 25-65); access authorization to the single use binary files is selectively disclosed to third party application providers in order to grant access for application loading (column 4, lines 29-33); application providers retrieve the current master “card unlock key” value from the binary file to which they have been given access (column 12, lines 16-42); the master “card unlock key” is then used to unlock the card and ready it for application loading (see column 12, lines 35-45); **Iijima** discloses after changing the operations of creating data files creating key elementary files, setting key data, so that gaining access to elementary files can be performed. Consequently by changing the key new values are written to all the files because all the elementary files can now be access by the new key (see column 4, lines 7-45) that meets the recitation of after the card is loaded with the desired application the master “card unlock key” value is changed to a random number and its new value rewritten to all

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of the binary files; **Iijima** further discloses the specific binary file from where the application provider first retrieved the master card unlock key file is then rendered unusable thereby restricting these as one time only keys (column 4, lines 29-40). **Iijima** is silent about the key is randomly generated and different from each card and each session. The use of one-time password and one-time randomly generating key is very well known in the art as disclosed for example in "Handbook of Applied Cryptography" by Menezes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Iijima** for providing a randomly generated key and different from each card so that each card is made unique to each user as suggested by **Iijima** and controlling access and authorization to manage the files by a specific user, thereby preventing unauthorized party to perform certain process for the files (see column 2, lines 37-62 and column 14, lines 10-25). One of ordinary skill in the art would have been motivated to do so because one of ordinary skill in the art would have recognized well known feature that keys are randomly generated so that keys cannot be guessed, and further changed the key as a measure of security after the key is transferred to eliminate fraud by inhibiting unauthorized party to perform certain process for the files as suggested by **Iijima** (see column 2, lines 37-62 and column 13, line 60 through column 14, line 25).

As per claim 6, **Iijima** discloses the limitation of further consisting of a second "card unlock key" known only to the card issuer which could override any other card operations thereby allowing specific applications to be deactivated (column 4, lines 25-56).

As per claim 7, Iijima discloses the limitation of wherein the said application loading can take place even after the card has been placed into circulation (see column 4, lines 29-53 and column 14, lines 10-25).

As per claim 8, Iijima discloses a method where new users are capable of creating new files and new keys for gaining access to files with great flexibility that meets the recitation of the limitation of wherein application loading is dynamic thereby affording greater flexibility than attempting to fit applications into a predefined card template (see column 4, lines 5-56 and figures 5, 15-16).

As per claim 9, Iijima discloses the claimed method of claim 1 performed by apparatus capable of erasing data stored in the card that meets the recitation of unloading applications (see column 54-67).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of memory allocations for loading specific applications in smart card.

US Patents: 6,594,746 Rabeler ; 4,985,615 Iijima; 5,604,800 Johnson et al ;
6,296,191 Hamann et al ; 6,005,942 Chan et al.

9.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cc

Carl Colin

Patent Examiner

February 3, 2006


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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